

REMARKS

With respect to the Office Action dated April 26, 2005, Applicant herein presents arguments to traverse the Examiner's 35 \$102(e), \$112, \$103(a) and double patenting rejections. Furthermore, Applicant presents arguments to traverse the Examiner's new matter objections.

In view of the Examiner's remarks in the Office Action of April 26, 2005, the Applicant has further amended claims 15, 24, 25 and 26, 27, and 28. Specifically, claims 15 and 26 have been amended to reflect that the auxiliary eyeglasses contain two appendages, one on each side, and that each one of the appendages contains magnetic material. Claims 24 and 25 have been amended to reflect that each one of the appendages of the auxiliary frames contains a second mating surface. Also, claims 15 27 and 28 have been amended to reflect that each one of the appendages of the auxiliary frames has a second socket. These amendments are supported by the specification, on page 10, line 24 - page 11, line 3, and also by Figures 1-9. No new matter has been added.

20 Claims 15 and 24-26 have also been amended to reflect that the "magnetic material on the auxiliary eyeglasses is capable of fitting solely below and mating with the magnetic material on the conventional eyeglasses such that said auxiliary eyeglasses are aligned with said conventional eyeglasses." The antecedent

basis for these amendments may be found in Figures 1-9 and on page 4, lines 4-12, page 10, line 21 through page 12, line 5 of the specification. No new matter has been added.

I. RESPONSE TO EXAMINER'S NEW MATTER OBJECTIONS UNDER 35 U.S.C. 132(a)

Examiner objected to the amendment of February 9, 2005, under 35 U.S.C. 132(a) on the ground that "introduces new matter into the disclosure." Specifically, Examiner states, "[t]he added material which is not supported by the original disclosure is as follows: said magnetic material **capable of fitting solely below** (emphasized) and mating with magnetic material on said conventional eyeglasses." See p. 2, ¶3.

New matter is defined as matter that is not disclosed in the original specification, claims or drawings. See MPEP 608.04(a) (emphasis added). Applicant respectfully traverses the Examiner's new matter objection because the language of the Applicant's claims, as currently amended, is in fact supported by the original specification and drawings and does not introduce any new matter into the disclosure.

Figures 1 through 9 fully disclose and support Applicant's newly amended claims. For example, Figure 1 shows that there are appendages (18) formed on the auxiliary eyeglasses (10) and that each one of the appendages (18) contains magnetic material (26). Also, Figure 3 shows that the magnetic material (26) fits only below the magnetic material (30) and that no part of the

magnetic material (26) is above the magnetic material (30). Further, it can be seen in Figures 2 and 3 that the auxiliary eyeglasses (10) and the primary eyeglasses (20) are aligned.

In order for the auxiliary eyeglasses (10) and the
5 conventional eyeglasses (20) to be properly aligned, the magnetic material (26) must be capable of fitting solely below the magnetic material (30). It can be easily realized from Figure 3 that if the magnetic material (26) is fitted above the magnetic material (30), the auxiliary eyeglasses (10) and the
10 conventional eyeglasses (20) will no longer be aligned, making the invention inoperable. As such, Figure 3 clearly shows that the magnetic material (26) of the auxiliary eyeglasses (10) is capable of fitting solely below (and incapable of fitting above) the magnetic material (30) of the conventional eyeglasses (20)
15 such that the auxiliary eyeglasses (10) are aligned with the conventional eyeglasses (20).

For this reason, the Applicant submits that the Applicant's disclosure in Figures 1-3 adequately supports Applicant's newly amended claims. Based on the foregoing, Applicant respectfully
20 requests the Examiner to withdraw his new matter objection and consider Applicant's current amendments and arguments in support of patentability.

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**II. RESPONSE TO EXAMINER'S REJECTIONS IN OFFICE ACTION DATED
APRIL 26, 2005**

A. Response to Rejection Under 35 U.S.C. 112

5 The Examiner has rejected claims 15-26 under 35 U.S.C. 112,
first paragraph, as failing to comply with the written
description requirement. Specifically, Examiner stated,

10 the specification fails to support for the limitations
'said magnetic material capable of fitting solely
(emphasized) below and mating with magnetic material
on said conventional eyeglasses' now claimed in the
independent claims 15, 24-26. Nowhere in the
specification provides support for such the
limitations.

15 Page 3, ¶15 (emphasis added).

The Examiner is mistaken in stating that the specification does
not provide support for the "capable of fitting solely below"
20 limitation. This can be confirmed by looking, for example,
to Figures 1-3, which clearly provide support for this
limitation, as shown by the Applicant above in traversing the
new matter rejection.

In providing support for the 35 U.S.C. 112, ¶1 rejection, the
25 Examiner stated,

30 [i]n fact the drawings, particular Fig. 4, show that
the magnetic material on the auxiliary eyeglasses not
only being 'capable of fitting below' but also
'capable of fitting above' and mating with magnetic
material on said conventional eyeglasses.

Page 3, ¶15 (emphasis added).

The Examiner is also mistaken that Figure 4 shows that the magnetic material on the auxiliary eyeglasses is "capable of fitting above" and mating with the magnetic material on the conventional eyeglasses "due to characteristics of magnetic attractive force." Looking to Figure 4, it can be seen that the magnetic material (26) of the auxiliary eyeglasses (10) fits below and mates with the magnetic material (30) of the conventional eyeglasses (20). The thick arrow in Figure 4 simply indicates that the clip (42) of the bridge (38) of the auxiliary eyeglasses (10) fits on top of the bridge (44) of the conventional eyeglasses (20). However, the clip (42), the bridge (38) and the bridge (44) are not magnetic, they are simply made of non-magnetic metal. Thus, in Figure 4, the magnetic material (26) of the auxiliary eyeglasses fits solely below the magnetic material (30) of the conventional eyeglasses.

Further looking to Figure 4, or to any one of the other eight figures, it can be seen that none of them show that the magnetic material is "capable of fitting above" such that the auxiliary eyeglasses are aligned with said conventional eyeglasses. In fact, if the magnetic material (26) of the auxiliary eyeglasses is fitted above the magnetic material (30) of the conventional eyeglasses, the auxiliary eyeglasses and the conventional eyeglasses will not be aligned, violating a limitation present in all of the amended claims.

In view of the above, all of the Figures in the Applicant's specification provide support for the currently amended claims. As such, the Examiner's 35 U.S.C. §112 rejection is improper and the Applicant respectfully requests that the Examiner withdraw
5 this rejection.

B. Response to §102(e) Rejection Over Chao

The Examiner has rejected claim 15 under 35 U.S.C. §102(e) as being anticipated by Chao et al., U.S. Pat. No. 6,012,811.
10 The Examiner did not reject independent claims 27 and 28 under Chao, and Applicant assumes that these claims are allowable in view of Chao et al. As to claim 15, the Examiner has stated that

15 [t]he limitations in claim 15 are shown in Chao et al.'s Fig. 16, column 8, lines 7-21. Chao et al discloses an apparatus for attaching auxiliary eyeglasses to conventional eyeglasses comprising: magnetic material 358 on said auxiliary eyeglasses; said magnetic material 358 capable of fitting below
20 and mating with magnetic material on said conventional eyeglasses, whereby said auxiliary eyeglasses are capable of being removably secured to conventional eyeglasses.

25 35 U.S.C. § 102 states that "[a] person shall be entitled to a patent unless - (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent. . . ." In applying § 102, MPEP § 706.02(a) instructs,
30 "for anticipation under 35 U.S.C. 102, the reference must teach

every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP §706.02(a) (page 700-21). The applicant respectfully traverses the § 102(e) rejection based upon Chao
5 because the reference does not teach every aspect of applicant's claimed invention as amended.

A critical aspect of Applicant's invention, as amended, is that the magnetic material on the auxiliary glasses is capable of fitting solely below the magnetic material on the
10 conventional glasses such that said auxiliary eyeglasses are aligned with said conventional eyeglasses. In other words, in order for the two frames to be aligned, the magnetic material (26) of the auxiliary glasses (10) must be capable of (have the ability of) fitting solely below the magnetic material (30) of
15 the conventional eyeglasses (20), i.e., without any part of the magnetic material 26 being above the magnetic material 30. These features are shown in Figures 1-3, illustrating the preferred embodiment. Because these features of claim 15, as amended, are not taught by Chao, Applicant respectfully
20 traverses the 102(e) rejection.

As discussed in more detail in Applicant's last Response of February 9, 2005, the Chao '811 patent only teaches an apparatus for attaching auxiliary glasses to conventional glasses where the auxiliary glasses have a U-shaped bridge always having a

magnet on the top arm. Thus, in *Chao*, all of the embodiments described in relation to Fig. 16 (cited by the Examiner) require that the magnetic material (356), (358) of the auxiliary glasses always attach to the conventional glasses from above, sometimes
5 from above and below, and never only from below. *Chao* does not describe a single embodiment where the magnetic material of the auxiliary eyeglasses has the ability to attach to the magnetic material of the conventional eyeglasses only (solely) from below such that the auxiliary eyeglasses are aligned with the
10 conventional eyeglasses.

In response to the above argument, the Examiner stated in his April 26, 2005 Office Action that "applicant does not discuss how the *Chao et al.*'s first magnetic material device is incapable of fitting below the second magnetic material on the
15 conventional eyeglasses." See page 8, ¶15. However, in view of the current amendment to the claims, the answer is clear, as shown in the following paragraph.

The Applicant's claims require that the magnetic material on the auxiliary glasses be capable of fitting solely below the
20 magnetic material on the conventional glasses such that said auxiliary eyeglasses are aligned with said conventional eyeglasses. If one were to attach *Chao*'s U-shaped structure (350) having the magnetic members 356 and 358 solely from below the magnetic member (360) of the conventional frame, the

auxiliary eyeglasses and the conventional eyeglasses will not be properly aligned and Chao's invention will be inoperable. In order to avoid this misalignment, the Chao's invention must always have magnetic material of the auxiliary eyeglasses above the magnetic material of the conventional eyeglasses. This teaches away from the Applicant's invention.

In addition, Chao does not disclose or describe a need for the magnetic material of the auxiliary glasses to attach solely below the magnetic material of the conventional glasses. In fact, Chao specifically describes the need for at least one magnetic material of the auxiliary frame (356) to always be above the magnetic material of the conventional eyeglasses for Chao's invention to properly function. See Chao '811 patent, Col. 8, lines 7-21.

Accordingly, since Chao does not disclose all elements of Applicants invention as they appear in the currently amended claims, Examiner's 102(e) rejection is not applicable and should be withdrawn.

B. Response to §103(a) Rejection Over Chao et al.

The Examiner rejected Claim 26 under U.S.C. § 103(a) as being unpatentable over Chao et al., U.S. Pat. No. 6,012,811.

The Examiner stated that although claim 26 is a method claim, the method steps consist of the broad steps of

"providing" and "mating" and therefore these steps would be inherently satisfied by the apparatus of the reference as modified.

The Examiner has rejected claims 26, a method claim, on obviousness grounds in view of *Chao*. However, the Examiner has not rejected independent Claim 15, an apparatus claim, encompassing the main elements of the invention on obviousness grounds here, just on anticipation grounds. In other words, the obviousness type rejection made by the Examiner is predicated on the Examiner's anticipation rejection pursuant to *Chao*. Since this anticipation rejection was traversed above, it is Applicant's position that the obviousness type rejection of claim 26 no longer applies.

As mentioned above, *Chao* specifically teaches a sandwich design, fitting magnetic material (356) of the auxiliary eyeglasses above and magnetic material (358) below the magnetic material (360) of the conventional glasses. Applicant, on the other hand, does not fit the magnets of the auxiliary glasses above the magnets of the conventional glasses, but accomplishes the attachment via fitting the magnetic material of the auxiliary glasses solely below the magnetic material of the conventional glasses such that said auxiliary eyeglasses are aligned with said conventional eyeglasses.

In a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims, and the modifications must be obvious to one of ordinary skill in the applicable art. As explained above, Chao does not
5 contain any teaching that would make the modifications obvious and, in fact, Chao teaches away from the present invention, rather than suggests its value.

Consequently, Chao does not teach or suggest all of the elements claimed by the Applicant in claim 26. Accordingly, the
10 103(a) rejection of claim 26 is not proper as is requested to be withdrawn.

C. Response To § 103(a) Rejection Based On Chao

The Examiner has rejected claims 1-28 under 35 U.S.C.
15 103(a) as being unpatentable over Chao, U.S. Pat. No. 5,568,207.

The Examiner states that the "limitations in claims 1-26 are shown in Chao's Figs. 3-7, column 2, line 33 through column 3, line 10. The Examiner admits that the "capable of fitting solely below" limitation is not found in Chao, but states that
20 "due to the characteristic of the magnetic attractive force, the first magnets capable of fitting above or below the second magnets would provide the same magnetic attractive force." This is exactly the same argument that the Examiner has already

unsuccessfully employed against the Applicant in the parent application, Ser. No. 09/184,694.

The Examiner advises that "the applicant should review the long prosecution of examination in the parent application serial
5 no.: 09/184,694 before amending claims and/or responding to the Office action." The Applicant is puzzled by this statement and would like to remind the Examiner that parent application 09/184,694 was found to be not obvious in view Chao and was allowed.

10 The Examiner is also reminded that the '694 application went to an Appeal Conference, and the conferees (John R. Lee (SPE), Olik Chaudhuri (SPE) and Huy Mai) agreed that the Applicant's bottom-mounted invention is not obvious in view of Chao's top-mounted invention described in the 5,568,207 patent.
15 As a result, the Examiner cannot once again use the '207 reference against the Applicant's claims containing the "capable of solely below" limitation because the issue of top versus bottom obviousness has already been decided in the Applicant's favor.

20 However, even if the use of the Chao reference was proper, the applicants claims, as currently amended, are not obvious in view of Chao. As mentioned above, Applicant's claims require that the magnetic material on the auxiliary glasses be capable of fitting solely below the magnetic material on the

conventional glasses such that said auxiliary eyeglasses are aligned with said conventional eyeglasses. If one were to attach Chao's magnetic members (22) on the arms (21) of the auxiliary eyeglasses solely from below the magnetic members (14) on the arms (11) of the conventional frame, the auxiliary eyeglasses and the conventional eyeglasses will not be properly aligned and Chao's invention will be inoperable. In order to avoid this misalignment, the Chao's invention must always have magnetic material (22) of the auxiliary eyeglasses above the magnetic material (14) of the conventional eyeglasses. This teaches away from rather than suggests the Applicant's invention.

For the above reasons, the 35 U.S.C. 103(a) rejection of Applicant's newly amended claims over Chao's '207 patent is improper and should be withdrawn by the Examiner.

D. Response to § 103(a) Rejection Based on Zider

The Examiner rejected Claims 15-17 and 24-26 under U.S.C. § 103(a) as being unpatentable over Zider. As basis for the rejection, the Examiner has used the language identical to the language he has already used in the Office Action of October 29, 2004. The Examiner did not reject independent claims 27 and 28 under Zider, and Applicant assumes that these claims are allowable in view of Zider.

The Examiner's rejection of claims 15-17 and 24-26 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Zider is respectfully traversed. The Applicant believes that this invention as presently claimed falls outside of the subject matter indicated, taught, or suggested by Zider. According to MPEP § 706.02(j):

10 "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art
15 reference (or references when combined) must teach or suggest all the claim limitations."

First, Zider does not teach or suggest all of the claim limitations of claims 15-17 and 24-26 as amended. Specifically, Zider does not teach or suggest an apparatus for attaching auxiliary eyeglasses to conventional eyeglasses where the magnetic material on the auxiliary eyeglasses is capable of fitting solely below and mating with magnetic material on the
25 conventional eyeglasses such that said auxiliary eyeglasses are aligned with said conventional eyeglasses.

A critical aspect of Applicant's invention is the orientation of magnets, which is shown more clearly in Fig. 3. According to the Applicant's invention, as amended, the magnetic
30 material (26) on the auxiliary glasses (10) has the ability to

fit wholly below (without any part of it being above) the magnetic material (30) on the conventional glasses (20) in such a way that the auxiliary eyeglasses (10) are aligned with the conventional eyeglasses (20). Such a disclosure is not present
5 in *Zider*.

Zider, as easily seen in its Abstract, teaches an apparatus for attaching auxiliary glasses to conventional glasses where the mounting arrangement includes a male part having a projection thereon and a female part having a recess therein.
10 Thus, in *Zider*, all of the embodiments described teach that the magnetic material of the auxiliary glasses always attaches to the conventional glasses from both above and below, and never only from below.

By definition, a male part has to go into the female part,
15 not be above it or below it. In other words, as seen in *Zider*'s Figure 5, once a magnetic projection (44) of the auxiliary lenses described in *Zider* goes into the magnetic recess (48) of the conventional lenses, the projection is in between, i.e., both above and below the sidewalls of the recess. Contrary to
20 *Zider*, Applicant's claims, as amended, include an element requiring that the magnetic material of the auxiliary lenses be capable of fitting only below the magnetic material of the conventional lenses in such a way that the auxiliary eyeglasses

are aligned with the conventional eyeglasses. This element is not taught or suggested by *Zider*.

In *Zider*, if the magnetic material of the male part of the auxiliary lenses is attached to the magnetic material of the female part of the conventional eyeglasses solely from below (instead of fitting within the female part), the two frames will be completely out of alignment with each other and the *Zider* invention would be inoperable. Thus, *Zider* does not teach all of the claim elements of claims 15-17 and 24-26.

Second, *Zider* provides no suggestion or motivation in itself or in combination with knowledge generally available to one of ordinary skill in the art, to modify *Zider* in order to meet all claim limitations of the Applicant's invention. In fact, *Zider* describes one of the main advantages of his invention being that the projection of the male part is fitted within and engages the recess of the female part, improving the holding power of the auxiliary eyeglasses onto the primary frame and preventing lateral movement of the auxiliary glasses with respect to the primary frame. See *Zider*, Col. 1, lines 62-65, Col. 2, lines 14-18 and 27-30.

The disclosure in *Zider* clearly teaches away from Applicant's invention because the whole purpose of the invention described in *Zider* is achieved by orienting one magnetic material (male) inside of a magnetic recess (female). In other

words, Zider teaches the magnetic material of the auxiliary glasses to be not only above or only below, but both above and below the magnetic material of the primary glasses.

For all of the above reasons, in view of the amendments and
5 remarks herein, the Zider reference does not make out a prima facie case of obviousness as to claims 15-17 and 24-26. Accordingly, the 103(a) rejection over Zider is improper and must be withdrawn.

E. Response To the Double Patenting Rejections

10 The Examiner has rejected claims 15-28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,550,913. To overcome this rejection, Applicant has filed a terminal disclaimer in compliance with 37 CFR 1.321 (c), which is
15 attached to this response. Thus, the double patenting rejection of claims 15-28 with respect to U.S. Patent No. 6,550,913 should be withdrawn.

The Examiner has also rejected claims 15-28 under the judicially created doctrine of obviousness-type double patenting
20 as being unpatentable over claim 7 of U.S. Patent No. 6,139,142. To overcome this rejection, Applicant has filed a terminal disclaimer in compliance with 37 CFR 1.321 (c), which is attached to this response. Thus, the double patenting rejection

of claims 15-28 with respect to U.S. Patent No. 6,139,142 should be withdrawn.

Applicant also acknowledges that the Examiner withdrew the previously-made double patenting rejection of claims 15-28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,705,722, after Applicant filed a terminal disclaimer in the previous response. Thus, all of the double patenting rejections made by the Examiner have been addressed and overcome by the Applicant through the use of timely filed terminal disclaimers.


III. CONCLUSION

In light of the above amendments and arguments, Applicant respectfully requests the allowance of this patent application. If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at (310) 777-8399.

Respectfully submitted,

Trojan Law Offices

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